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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/157,998	09/22/1998	RONALD LESSER		3406

7590

05/21/2002

J. Mark Holland
Professional Law Corporation
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Newport Beach, CA 92660

EXAMINER

JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/157,998

Applicant(s)
Lesser

Examiner
Romain Jeanty

Art Unit
2163



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 25, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-73, 77-85, and 87-93 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-73, 77-85, and 87-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3623

DETAILED ACTION

Response to Amendment

1. The following is a Non-final office Action in response to the amendment filed on February 25, 2002. By the amendment, claims 49, 51, 55, 57, 58, 59 and 68, have been amended. Claims 91-93 have been added. Claims 49-73, 77-85, 87-93 now are pending in this application.

Claim Rejections - 35 USC § 112

2. Claim 91 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 91 constitutes a single means by assuming the electronic means for performing many functions. Processing of medical examinations to determine codes is necessary for the electronic means to perform the claimed functions. Thus the single means is assumed to perform a plurality of functions. No other physical structure or means is recited in the claim. Claim 91 is therefore rejected in accordance with **In re Hyatt**, 218 USPQ 195 (Fed. Cir. 1983). Note MPEP 2164.08(a). This claim covers every conceivable the entities or items recited while the specification discloses only those “means” known to the inventors.

3. Claim 91 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, the claim recites “Centers for Medicare & Medicaid Services”.

Art Unit: 3623

The specification fails to disclose how such "Centers for Medicare & Medicaid Services" can be called HCFA, and, therefore, the person of ordinary skill in the art would have to perform unnecessary experimentation in order to make or use this aspect of the invention.

4. Claims 51, 55, 57, 58, 59, 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 51, the term "the medical services", there is insufficient antecedent basis for this limitation in the claim in claim 51.

As per claim 55, the term "the information gatherer", there is insufficient antecedent basis for this limitation in the claim in claim 55.

As per claim 57, the term "the preceding responses". There is insufficient antecedent basis for this limitation in claim 55.

Claims 58, 59, 68, recites the term "information including at least sufficient details to support billing requirements imposed by HFCA **instead** of....". However, the term "**instead**" renders the claim vague and indefinite because it is unclear as to the positive functionality being recited. The Examiner suggests applicant to clearly recite the particular function instead of reciting what the function is not.

All other claims that depend on the above rejected claims, inherent same deficiency as the parent claims.

Art Unit: 3623

Allowable Subject Matter

5. Independent claims 51, 55, 57, 58, 59, 68 and their dependent claims would be allowable if overcome the 112 second rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed **Romain Jeanty** whose telephone number is **(703) 308-9585**.

The examiner can normally be reached on weekdays from 7:30 a.m to 6:00 pm.

If attempts to reach the examiner are not successful, the examiner's supervisor, **Tariq R Hafiz** can be reached at **(703) 305-9643**.

Any inquiry of a general nature or relating to the status of this application or preceding should be directed to the group **receptionist** whose telephone number is **(703)308-3900**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C 20231

or faxed to:

(703) 746-7238 (After-Final communication)

(703) 746-7239 (Official communication)

Art Unit: 3623

(703) 746-7240 (Informal or draft communication labeled (“PROPOSED” or
“DRAFT”).

Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive,
Arlington VA., fourth floor receptionist.

RJ

May 19, 2002.

Frantzy Poinvil
FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628